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### REMARKS

#### **35 U.S.C. § 112 Rejection**

The Examiner rejected claims 9, 10 and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, claim 9 has been amended to properly depend from claim 8 instead of from claim 7.

Regarding claim 13 has been amended herein to remove the phrase "a substantial portion of". Thus claim 13 no longer requires that a substantial portion of the memory to be written.

It is believed that the amendments to claims 9 and 13 overcome the rejection.

#### **35 U.S.C. § 102 Rejection**

The Examiner rejected claims 1-4, 8, 9, 11-13 and 20 under 35 U.S.C. § 102(e) as being anticipated by Shih (6,490,637) and further rejected claims 1, 5, 11, 14 and 20 under 35 U.S.C. § 102(e) as being anticipated by Hall, Jr. et al. (6,308,281).

Independent claims 1 and 11 have been amended herein to recite that the "*identifying indicia includes graphics data*". Since the art does not disclose all of the elements in the Applicant's independent claims 1 and 11 as amended including that the identifying indicia includes graphics data, it is believed that claims 1 and 11 as amended and their respective dependent claims are not anticipated, so the rejection should be withdrawn.

#### **35 U.S.C. § 103 Rejection**

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Hall, Jr. et al. (6,308,281) in view of Blodgett et al. (6,163,489), and further rejected claims 7 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Hall, Jr. et al. (6,308,281) in view of Doshi et al. (6,349,138). The Examiner also rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Shih (6,490,637) in view of Doshi et al. (6,349,138), and further rejected claim 19 under 35 U.S.C. § 103(a) as being

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unpatentable over Shih (6,490,637) in view of Haynes (WO 97/19414) and Bhatia et al. (6,118,768). The Examiner additionally rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Hall, Jr. et al. (6,308,281) in view of Haynes (WO 97/19414), and further rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Hall, Jr. et al. (6,308,281) and Haynes (WO 97/19414) as applied to claim 18 above, and further in view of Bhatia et al. (6,118,768). The Examiner also rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Shih (6,490,637) in view of Micali (5,793,868), and further rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Hall, Jr. et al. (6,308,281) in view of Micali (5,793,868).

As discussed with respect to the § 102 rejection, above, independent claims 1 and 11 have been amended herein to recite that the *"identifying indicia includes graphics data"*. The art does not disclose all of the elements in the Applicant's independent claims 1 and 11 as amended including that the identifying indicia includes graphics data. An obviousness rejection requires that all of the claimed elements be found in the prior art, which they are not. The Examiner is kindly reminded that:

The prior art reference (or references when combined) must teach or suggest all the claim limitations (MPEP §§ 2142, 2143).

Since the references do not teach that the identifying indicia includes graphics data, the rejection should be withdrawn.

Regarding graphics data, the Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Shih (6,490,637) and Micali (5,793,868) as applied to claim 21 and further in view of Jones (5,500,681).

As stated by the Examiner regarding Shih and Micali, "They do not say that the serial number is stored in compressed image format." In addition, the Examiner stated that, "In lines 1-4 of column 9, Jones discusses converting an identification number to an image format and storing the result." For convenience, the relevant sentence of lines 1-4, column 9, are reproduced:

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Similarly, coupon processor 98 converts the ASCII-encoded cable company identification number to an image format and writes additional image data 128 to image memory 118

It should be noted that the patent to Jones is directed to an apparatus and method for generating product coupons in response to televised offers. The image information is a "cable company identification number" and is thereby associated with the cable company, not *"identifying indicia unique to the modem, wherein the identifying indicia includes graphics data"* as claimed in independent claim 1, nor a *"program adapted to cause the processor, under control of the program, to read identifying indicia stored integrally within the modem and communicate the identifying indicia to a host communicating with the modem, wherein the identifying indicia includes graphics data"* as claimed in independent claim 11.

In further support of the rejection, the Examiner stated that:

Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to store Shih's serial number as a compressed image, whereby it could be used as a seal.

The Applicant respectfully traverses this assertion by the Examiner. First, there is no evidence in the cited references to support the Examiner's assertion. The cited passage in Jones only discusses converting cable company information into an image format, however it is silent with respect to the remaining elements or concepts of the Applicant's claims, for example identifying indicia unique to a modem. Second, there is *no motivation* in the prior art to combine any image format of Jones into a Shih or a Micali system, and the Examiner has provided no evidence of such *motivation*. The Examiner is kindly reminded that, in order to support a *prima facie* obviousness rejection:

There must be some suggestion or motivation, either in the references themselves or from knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (See MPEP §§ 214, 2143).

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Nowhere has the Examiner pointed to any motivation or suggestion in the art *to combine* the teachings of Jones with the teachings of Shih and Micali. The Examiner is kindly requested to cite the passage in the cited references where the motivation or suggestion *to combine* exists, or to otherwise withdraw the rejection. The Examiner is kindly reminded that the prior art must suggest the desirability of the claimed invention. See MPEP § 2143. Third, it is not clear what the Examiner is referring to with regard to a “seal” since the word “seal” appears neither in the patent to Shih, nor in the patent to Micali, nor in the patent to Jones, nor in the Applicant’s claims. The Applicant kindly requests the Examiner to explain how this supports the obviousness rejection and where in the cited references such support appears or to otherwise withdraw the rejection. If the evidence in support of the rejection, such as the above mentioned motivation to combine the references, is based upon the Examiner’s own personal knowledge, the Applicant hereby traverses the rejection and hereby kindly requests the Examiner to set forth such facts, including the date on which the facts were known, in an Examiner’s affidavit or to otherwise withdraw the rejection. MPEP 2144.03; 37 CFR 1.104(d)(2)

#### New Claims

The Applicant presented new claims 22-27. Support for the limitations in new claims 22-27 may be found in the specification at least on page 7, lines 16-17 and on page 14, lines 1-2. No new matter has been added. It is believed that the new claims are allowable over the art.

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### Conclusion


In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

### Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, Kenneth J. Cool, at (408) 850-1229 if there remains any issue with allowance.

Respectfully submitted,  
INTEL CORPORATION

Date: 12/17/03

  
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